

### **REMARKS**

The present application was filed on December 4, 2003 with claims 1-26. Claims 9-26 have been withdrawn from consideration, so claims 1-8 remain pending in the application.

In the Office Action of December 29, 2006, the Examiner rejected claims 1 and 3-8 on the grounds of nonstatutory obviousness-type double patenting as unpatentable over claims 1-12 of U.S. Patent No. 6,878,757 to Roby (hereinafter Roby '757"). While not necessarily agreeing with the Examiner's characterization of Roby '757 and the subject matter it discloses, Applicant will file a suitable terminal disclaimer upon indication that the claims are otherwise allowable in this application.

The Examiner has rejected claims 1-8 under 35 U.S.C. §103 (a) as obvious over U.S. Patent No. 5,716,376 to Roby (hereinafter "Roby '376") in view of U.S. Patent No. 4,201,216 to Mattei ("Mattei"). Roby '376 does not disclose or suggest a coating for a surgical article comprising: a) a copolymer having a predominant amount of epsilon-caprolactone and a minor amount of at least one other bioabsorbable copolymerizable monomer; and b) an effective antimicrobial amount of a metal salt of a fatty acid selected from the group consisting of fatty acid salts of lithium, rubidium, cesium, francium, beryllium, magnesium, strontium, barium, radium, aluminum, tin, lead, bismuth, transition metal and mixtures thereof as recited in claim 1.

Mattei fails to remedy the deficiencies of Roby '376. Nowhere does Mattei disclose or suggest a coating for a surgical article comprising: a) a copolymer having a predominant amount of epsilon-caprolactone and a minor amount of at least one other bioabsorbable copolymerizable monomer; and b) an effective antimicrobial amount of a metal salt of a fatty acid selected from the group consisting of fatty acid salts of lithium, rubidium, cesium, francium, beryllium,

magnesium, strontium, barium, radium, aluminum, tin, lead, bismuth, transition metal and mixtures thereof as recited in claim 1. Mattei's copolymer is preferably lactide and glycolide; nowhere in Mattei is there any mention or suggestion of epsilon-caprolactone. Moreover, as acknowledged by the Examiner, Mattei prefers calcium salts of stearic, palmitic, and oleic acids; calcium salts are not recited in claim 1.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. See MPEP §2143. The Examiner suggests, without any support, that one skilled in the art would have found it obvious to utilize the recited salts in preparation of coatings for sutures, "if the associated and required dip-coating process were an acceptable means of manufacture." (See Office Action at page 6.) However, this unsupported assertion ignores the fact that the language quoted by the Examiner from applicant's specification notes that a dip coating process is not necessarily desirable: the use of a calcium stearate in a coating would require an *impractical and uneconomical* dip coating process. See Specification at page 2, line 19 to page 3, line 2. Here, to combine the references as suggested by the Examiner requires impermissible hindsight, i.e., applicant's own disclosure, to provide the impetus to combine the references. Thus, contrary to the Examiner's assertions, there is no motivation or suggestion to combine the references as suggested by the Examiner, nor is there any reasonable expectation of success.

Thus, it is respectfully submitted that neither Roby '376 nor Mattei, taken alone or in any combination, render claim 1 obvious, nor claims 2-8 which depend, directly or indirectly, therefrom.

Therefore, for at least the foregoing reasons, neither Roby '376 nor Mattei render obvious claims 1-8 of the instant application and reconsideration of this rejection is respectfully requested.

It is believed that the pending claims of the application, i.e., claims 1-8, are patentably distinct over the art of record and are in condition for allowance. In the event that the Examiner believes that a telephone conference or a personal interview may facilitate resolution of any remaining matters, the undersigned may be contacted at the number indicated below. Early and favorable reconsideration of this application is respectfully requested.

Respectfully submitted,



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